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Patent
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Trademark Law

March 7, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3621
Patent Examiner **Jalatee Worjlo**

Re: Application No.: **09/193,787**
Confirmation No.: **2446**
Applicants: **Jay Paul Drummond, et al.**
Title: **Automated Banking Machine
Apparatus and System**
Docket No.: **D-1077+1**

Sir:

Please find enclosed a Request for Clarification in response to the Office Action dated February 16, 2006 for filing in the above identified Application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Response and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 this 7th day of March 2006.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Request For Clarification

Applicants request clarification of the record in response to the defective Office Action (“Action”) dated February 16, 2006. This Request is being made as a courtesy to the Office. Applicants provide opportunity for the Office to correct the defective Action now, instead of later under remand from the Board of Patent Appeals and Interferences. Applicants, in their unvarying quest for compact patent prosecution, are trying to avoid even further Office-caused prosecution delay.

Reasons Why The Action Is Defective

Claim 15

The Action is defective because it does not specifically state on the record that claim 15 is allowed. As claim 15 has not been rejected or objected to, it must be regarded by Applicants as allowed. The allowance thereof is greatly appreciated. Clarification of the record to reflect the allowed status of claim 15 is requested.

Claims 2-7, 10, 12, 14, and 17-30

The Action is defective because it provides no statutory basis for the rejection at paragraph number 10 (on page 5). Nor can a claim be legally rejected just because it depends on another claim. As best understood, Action paragraph number 10 (on page 5) includes a typographical error. The term “rejected” should read as “objected”. The language used by the Office in paragraph number 10 points to that in MPEP form paragraph 7.43. Thus, it must be regarded by Applicants that claims 2-7, 10, 12, 14, and 17-30 are “objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims” (MPEP form paragraph 7.43). Clarification of the record to reflect the objected to status of these claims is requested.

The rejection of claims 8, 9, 11, 13, and 16 based on claim 1 of application 09/233,249

The Action (at paragraph number 9) indicates that “These claims are rejected on the same rationale as [Applicants’] independent claim 1 above”. However, Applicants’ claim 1 was rejected based on claim 12 (not claim 1) of application 09/233,249. No valid rationale has been provided with regard to claim 1 of application 09/233,249. Thus, the Action is defective.

Clarification of the record to reflect how claims 8, 9, 11, 13, and 16 correspond to claim 1 of application 09/233,249 is requested.

The Action lacks explanations for the rejections

Applicants respectfully submit that the Action is defective because it does not comply with the rules of the Patent Office. The Action is silent concerning any discussion of claim 1 of application 10/980,209 or claim 1 of application 09/233,249 with regard to any of Applicants' claims 8, 9, 11, 13, and 16. The Action is defective because it does not state on the record how claims 8, 9, 11, 13, and 16 correspond to the respective claim 1 in each of these applications. Applicants' claims 8, 9, 11, 13, and 16 differ from Applicants' claim 1. Thus, no valid explanation for the rejections has been provided. Applicants request that the Office provide a claim by claim comparison, similar to that in Action paragraphs 6 and 7. Applicants have a right to know the reasons why their grant of patent is being denied.

35 U.S.C. § 132 states that “Whenever, on examination, any claim for a patent is rejected . . . the Director shall notify the applicant thereof, stating the reasons for such rejection . . . together with such information . . . as may be useful in judging of the propriety of continuing the prosecution of his application.” Furthermore, 37 C.F.R. § 1.104 (c) (2) requires that “the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained” by the Office. An Action is to provide communication that “fully and clearly stated” the rejection, as is required by MPEP 707.07(d). Additionally, an Action is to “present a convincing line of reasoning” for the rejections, in accordance with MPEP 706.02(j). An Action is also to “properly communicate the basis for a

rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply”, in accordance with MPEP 706.02(j).

Because the basis for the rejections has not been properly communicated, resulting in a defective Action, Applicants have not been given a fair opportunity to properly reply. That is, Applicants have been left with the burden of trying to properly respond to an unclear, incomplete, and deficient Action. Clarification of the record is requested.

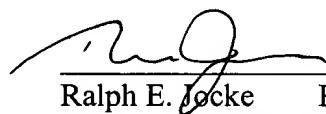
Request for a new period for reply

Applicants request that the Office restart the time for reply in accordance with MPEP 710.06. Applicants reserve all rights to provide Response (e.g., remarks, amendment, appeal, etc.) to the Office Action dated February 16, 2006.

Conclusion

For the reasons discussed above, clarification of the record is requested. The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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